

## **REMARKS**

### **I. General**

Claims 1-20 are pending in the application. Claims 2, 5-8 and 10-20 stand rejected under 35 U.S.C. § 112. Claims 1, 3, 4 and 9 are allowed. Applicant thanks the Examiner for the indication of allowability for claims 1, 3, 4 and 9. Applicant hereby traverses the outstanding rejections, and respectfully requests reconsideration and withdrawal in light of the remarks and amendments contained herein.

### **II. Amendments to the Claims**

Claims 2, 4, 11 are amended to more clearly define the invention. These amendments are not intended to limit the scope of the claims in light of any cited or prior art. Applicant asserts that support for these amendments can be found in the originally-filed application, at least, in paragraph [0030], and the originally-filed claims. Applicant further asserts that no new matter has been added.

New claims 21 and 22 are added. Applicant asserts that support for these new claims can be found in the originally-filed specification, at least in paragraph [0030], and that no new matter has been added. Applicant further asserts that new claims 21 and 22 are patentable.

### **III. Rejections under 35 U.S.C. § 112**

Claims 2, 5-8 and 10-20 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. The Office Action identifies claims 2, 5, 8, 10, 11, 13, 14 and 17 as specifically rejected under 35 U.S.C. § 112, second paragraph. The rejections of claims 6, 7, 12, 15, 16 and 18-20 result from the rejections of claims 5, 10 and 17.

#### **A. Claims 2, 11 and 14**

The Office Action states that the phrase “and combinations of said parameters” in claims 2, 11 and 14 fails to define the metes and bounds of the claimed invention. Applicant

notes that claim 2 depends from claim 1, and claims 11 and 14 depend from claim 10. Applicant further notes that claim 14 contains the phrase “and combinations of said decision criteria.”

Claim 1 recites “at least one operating parameter,” which is further defined by claim 2 reciting “wherein said at least one operating parameter is selected from ...” The language of claim 1 already allows for selection of multiple operating parameters, where multiples of operating parameters constitute combinations of operating parameters. Thus, the phrase “combinations of said operating parameters” may be deleted from claim 2 without adding new matter. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claim 2.

Similarly, claim 10 recites “at least one differing operating parameter,” which is further defined by claim 11 reciting “wherein said at least one differing operating parameter is selected from ...” The language of claim 10 already allows for selection of multiple differing operating parameters, where multiples of operating parameters constitute combinations of operating parameters. Thus, the phrase “combinations of said operating parameters” may be deleted from claim 11 without adding new matter. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claim 11.

Claim 14 recites four specific decision criteria, along with the phrase “and combinations of said decision criteria.” Applicant respectfully asserts that one of ordinary skill in the art would understand that “combinations of said decision criteria” comprises different possible combinations of the four specifically-recited criteria. Accordingly, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claim 14.

#### B. Claim 5

The Office Action states that the phrase “said phase patterns” in claim 5 does not refer to the language of claim 4 in the alternative, and then asks how claims 5-7 further limit the other alternatives. Applicant notes that claim 4 is amended to clearly recites the language of a Markush group, as reflected in M.P.E.P.2173.05(h), and that claim 5 clearly identifies one

alternative, "phase patterns," as being further limited. Applicant respectfully asserts that claims 5-7 are not required to further limit the other alternatives. Claims 6 and 7 depend from claim 5, and their rejections result from the rejection of claim 5. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of claims 5-7.

C. Claims 8, 10 and 17

The Office Action states that the difference between "optical navigation device" and "optical navigation system" are not adequately defined in claims 8, 10 and 17. Applicant respectfully asserts that one of ordinary skill in the art would understand that claims 8, 10 and 17 define "optical navigation device" as a moving portion of an "optical navigation system," but that an "optical navigation system" may also comprise "navigation terrain," as recited in the claims. The rejections of claims 12, 15, 16 and 18-20 result from the rejections of claims 10 and 17. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejections of claims 8, 10, 12 and 15-20.

D. Claim 13

The Office Action states that there is no antecedent basis for "a plurality of said first sources and said second sources," but there is antecedent basis in claim 10 for "a first source and a second source." Claim 13 is amended to comply with the antecedent basis provided by claim 10. Therefore, Applicant respectfully requests withdrawal of the 35 U.S.C. § 112, second paragraph, rejection of claim 13.

**IV. Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance.

Application No. 10/697,421  
Amendment dated March 22, 2006  
Reply to Office Action of December 23, 2005

Docket No.: 10030567-1

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 50-3718, under Order No. 10030567-1 from which the undersigned is authorized to draw.

Dated: March 22, 2006

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV 628782754US, on the date shown below in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Dated: March 22, 2006

Signature: 

(Phyllis Ewing)

Respectfully submitted,

By 

Michael A. Papalas

Registration No.: 40,381

(214) 855-8186

(214) 855-8200 (Fax)

Attorney for Applicant